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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,380	05/26/2000	Bradford W. Gibson	UCSFP001/1584.002	1111
27476	7590	11/04/2004	EXAMINER	
Chiron Corporation Intellectual Property - R440 P.O. Box 8097 Emeryville, CA 94662-8097			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/580,380

Applicant(s)

GIBSON ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED October 20, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 12 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3, 5, 8-14, 21-24, and 75-82.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The proposed new limitations of "a mass spectrometric analysis to identify sequences of the fragments", line 6-7, and "physical distance constraint information associated with the cross-linking", lines 12-13, raise new issues that would require further consideration and/or search.

It is noted that claim 1, lines 12-13, previously recited the broad limitation of "physical distance constraint information" which is different from the proposed limitation of "physical distance constraint information associated with the cross-linking". The same issue is present in claims 5, 8, 21, 24, 78, and 81.

It is noted that claim 78, line 6-9, recites "a mass spectrometry identification procedure...to identify "distance constraint information" which is different from the proposed limitation of "a mass spectrometric analysis to identify sequences of the fragments". The same issue is present in claim 8.

Continuation of 5. does NOT place the application in condition for allowance because:

Claims 1-3, 5, 8-14, 21-24, and 75-82 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained with respect to claims 1-3, 5, 8-14, 21-24, and 75-82 as recited in the previous office action mailed March 09, 2004.

Applicant's argument via the proposed amendments to the claims has been fully considered and found to be unpersuasive because of the non-entry of said amendments as discussed above.

Claims 1-3, 5, 8-14, 21-24, and 75-82 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for using the tertiary structure (3D) of a macromolecule such as a protein by cross-linking said protein for analysis by mass spectroscopy, does not reasonably provide enablement for the determination of the tertiary structure (3D) of a macromolecule such as a protein by any other methods (X-ray crystallography etc.). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This rejection is maintained with respect to claims 1-3, 5, 8-14, 21-24, and 75-82 as recited in the previous office action mailed March 09, 2004.

Applicant argues that the claims are enabled because the instant "claimed invention specifies detailed techniques for using cross-link information". Applicant argues that the "information optionally supplemented with other data such as NMR data sets or X-ray diffraction patterns that might require more than routine skill to analyze is wholly irrelevant" in regard the claimed invention being enabled. Applicant's argument has been acknowledged and found to be unpersuasive because the limitation of "the candidate three-dimensional conformations...that best fit the distance constraint information" as recited by claim 1 is not an optional limitation. The required limitation of "the candidate three-dimensional conformations" causes the claimed invention to be not enabling as commensurate in scope with the claims. It is noted that claims are examined as a whole. While, there are enabled embodiments; the non-enabled embodiments causes the claimed invention to be not enabling as commensurate in scope with the claims.

Applicant's argument directed to the claimed invention being enabled beyond the use of the equation recited in claim 24 for performing the claimed method has been found to be unpersuasive.

Therefore, the lack of enablement rejection as directed to the claimed invention not being enabled for any mathematical equations beyond the one recited in claim 24 has been withdrawn. However, the instant rejection has been maintained as directed to the claimed invention not enable for the determination of the tertiary structure (3D) of a macromolecule such as a protein by any other methods (X-ray crystallography etc.).

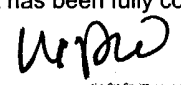
Claims 1-3, 5, 8, 14, 21-24, and 75-82 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lacroix et al. (1997).

This rejection is maintained with respect to claims 1-3, 5, 8, 14, 21-24, and 75-82 as recited in the previous office action mailed March 09, 2004.

Claims 1-3, 5, 8-14, 21-24, and 75-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacroix et al. (1997) taken with Mitra et al. (1979).

This rejection is maintained with respect to claims 1-3, 5, 8-14, 21-24, and 75-77 as recited in the previous office action mailed March 09, 2004.

Applicant argues that the proposed claims recite the limitation of "physical distance constraint information associated with the cross-linking" has caused the claimed invention to overcome the cited prior art. Applicant's argument has been fully considered and found to be unpersuasive due to the non-entry of the proposed claim amendments.


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11/2/04